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In re Application of	:	OFFICE OF PETITIONS
Tadayoshi Okada et al.	:	
Application No. 10/663,060	:	DECISION ON RENEWED PETITION
Filed: September 12, 2003	:	UNDER 37 C.F.R. §1.181(A)
Attorney Docket Number: A35998-	:	
074224.0118	:	
Title: HIGH-STRENGTH BOLTED	:	
CONNECTION STRUCTURE WITH NO	:	
FIRE PROTECTION	:	

This is a decision on the renewed petition under 37 CFR §1.181(a), filed June 16, 2006, to withdraw the holding of abandonment. It is noted that Petitioner has included a one-month extension of time to make timely this response.

BACKGROUND

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR §1.113 in a timely manner to the final Office action mailed June 24, 2005, which set a shortened statutory period for reply of three (3) months. No response was received, and no extensions of time under the provisions of 37 CFR §1.136(a) were obtained. Accordingly, the above-identified application became abandoned on September 25, 2005.

The original petition was submitted on January 11, 2006, and was dismissed via the mailing of a decision on March 16, 2006.

RELEVANT PORTION OF THE C.F.R.

37 CFR §1.8(b) sets forth, *in toto*:

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence, or after the application is held to be abandoned, or after the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

ANALYSIS

With the original petition, Petitioner asserted that on October 19, 2005, a response to the notice was timely submitted in conjunction with a one-month extension of time via facsimile transmission. Petitioner supplied a copy of this response with the original petition, and the response contained a certificate of facsimile transmission dated October 19, 2005. This response was considered by the Examiner, and it was determined by the same that it failed to place the application in condition for allowance. As such, the petition was dismissed via the mailing of a decision on March 16, 2006. An advisory action was included with this decision, indicating that the response which was submitted on January 11, 2006¹ failed to place this application in condition for allowance.

With this renewed petition, Petitioner now asserts that the advisory action "apparently does not concern the facsimile after-final response of October 19, 2005...the enclosed Advisory Action concerns Petitioner's RCE filing of January 9, 2006²." It

¹ Petitioner had affirmatively represented the response which was submitted with the petition on January 11, 2006 to be a copy of that which was originally transmitted to the Office on October 19, 2005.

² Renewed petition, page 2.

is noted that Petitioner has previously attested, over his registration number, that the documents which were enclosed with the original petition were the same documents which were presented to the Office on October 19, 2005³. It is not clear why Petitioner would assert that the advisory action does not concern the facsimile of October 19, 2005, when he has previously represented that the submission of January 11, 2006 is a copy of that which was submitted on October 19, 2005. If the two submissions are identical, as Petitioner has previously held them out to be, if the advisory action concerns one submission, it must concern the other.

It is clear from rules 37 C.F.R. §§1.116 and 1.135 that abandonment of an application is risked when the applicant proffers an amendment after the mailing of a final Office action. The rule clearly indicates that the mere filing of an amendment does not relieve applicant of the duty to take appropriate action to save the application from abandonment.

If steps are not taken after final to maintain pendency prior to the expiration of the maximum extendable period for reply, the application will go abandoned. Put another way, the submission of an after final amendment which fails to place the application in condition for allowance will result in the abandonment of the application, unless one of the following four items is filed prior to the maximum extendable period for reply:

- a subsequent amendment which places the application in condition for allowance;
- a Notice of Appeal;
- a Request for a Continuation Application pursuant to 37 C.F.R. § 1.53(b), if applicable;
- a Request for Continued Examination pursuant to 37 C.F.R. §1.114, and;
- a Terminal Disclaimer, if applicable.

Petitioner received a final Office action, and submitted an after-final response, which failed to place the application in condition for allowance. Petitioner will note that had the after-final amendment placed the application in condition for allowance, consisted of a notice of appeal, or consisted of an RCE, the previous petition would have been granted, and the holding of abandonment would have been withdrawn. But such is not the case – Petitioner submitted an after-final amendment which failed to place the claims in condition for allowance. As such, *the after-final amendment, even if it had been received*

³ Original petition, page 2.

and processed when it was originally submitted, could not have been accepted, and the present application would have gone abandoned.

Petitioner is effectively requesting that the Office accept the RCE, which was filed with the original petition, and treat the same as if it had been submitted along with the after-final amendment which failed to place the application in condition for allowance. This cannot be done, as the Office has no authority to accept a response as timely filed if filed after the maximum extendable period for reply.

CONCLUSION

The petition must be **DISMISSED**.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail⁴, hand-delivery⁵, or facsimile⁶.

NOTICE:

Any reply must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reply should include a cover letter entitled "Second Renewed Petition Under 37 C.F.R. §1.181." This is not a final agency action within the meaning of 5 U.S.C 704.

Thereafter, there will be no further reconsideration of this matter^{7, 8}.

⁴ Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

⁵ Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

⁶ (571) 273-8300- please note this is a central facsimile number.

⁷ For more than a century, punctuality and due diligence, equally with good faith, have been deemed essential requisites to the success of those who seek to obtain the special privileges of the patent law, and they are demanded in the interest of the public and for the protection of rival inventors. See: Porter v. Louden, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894). An invention benefits no one unless it is made public, and the rule of diligence should be so applied as to encourage reasonable promptness in conferring this benefit upon the public. Automatic Electric Co. v. Dyson, 52 App. D.C. 82; 281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. §6; 37 C.F.R. §§1.181, 182, 183.

⁸ If, on the second request for reconsideration, Petitioner fails to satisfy the showings burden required: (a) the resulting decision may be one viewed as

Petitioner's only relief is a petition under 37 C.F.R. §1.137(a) and/or (b)⁹. Having been made aware of this reality - Petitioner's delay in promptly seeking relief under 37 C.F.R. §1.137 may be considered evidence of intentional delay and an absolute bar to revival.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

It is noted in passing that Petitioner has further requested that the Office treat this petition as a petition under 37 C.F.R. §1.182 and/or §1.183.

37 C.F.R. §1.182 concerns situations which are not otherwise provided for in the rules. 37 C.F.R. §1.182 does not apply to the present situation, as it is clear that the rules provide for situations where a petitioner files an after-final amendment which fails to place the application in condition for allowance, and the application consequently goes abandoned. See 37 C.F.R. §1.137.

The filing of a petition under 37 C.F.R. §1.183 is appropriate when a practitioner seeks to have the Office waive a particular rule. Before the Office can act on a petition to waive a particular rule however, Petitioner must identify which rule it is that he wishes to have waived.

Consequently, neither request can be acted upon, and Petitioner's Deposit Account has not been charged for these two petitions. If on renewed petition Petitioner chooses to file a petition under 37 C.F.R. §1.183, he should indicate which rule it is that he wishes to have waived.



**Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office**

final agency action; and (b) provisions for reconsideration, such as those at 37 C.F.R. §1.137(e), will not apply to that decision.

9 Upon the granting of a petition under 37 C.F.R. §1.137, the RCE will be entered and the previously filed after-final amendment shall serve as the submission. Alternatively, Petitioner of course is free to submit another amendment to serve as the submission.